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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/013,105	11/06/2001	Christopher Scott Brehm	18360/233830	9449
826	7590	05/24/2006	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			BORISOV, IGOR N	
		ART UNIT	PAPER NUMBER	
			3639	

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/013,105	BREHM ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Igor Borissov	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 20 March 2006.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1,2,4-13,15,37,39-41 and 57-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,4-13,15,37,39-41 and 57-60 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Amendment***

Amendment received on 3/20/2006 is acknowledged and entered. Claims 3, 14 and 38 have been canceled. Claims 1, 4, 37, 39, 40 and 41 have been amended. Claims 19-36, 42-56 have been withdrawn. Claims 1, 2, 4-13, 15-18, 37, 39-41 and 57-60 are currently pending in the application.

### ***Claim Rejections - 35 USC § 101***

Claim Rejections under 35 USC § 101 have been withdrawn due to the applicant's amendment.

### ***Claim Rejections - 35 USC § 112***

Claim Rejections under 35 USC § 112 have been withdrawn due to the applicant's amendment.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-18, 37-41 and 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Humes et al. (US 5,377,120) in view of Oh, Je H. (EP 0 575 109 A1).**

Humes et al. (Humes) teaches an apparatus for processing mail pieces, comprising:

#### **Independent Claims**

Claim 1,

a holding facility for receiving stacks of mails from senders and gather said stacks into one or more hoppers (Figs. 2 and 3; items 44-45; C. 3, L. 61-62);

a pre-sorting business to receive said gathered mail from said holding facilities and sort said mail pieces into a pre-sorted batch (Fig. 3; items 61 and 63; C. 5, L. 34-38).

While Humes does teach receiving stack of mail pieces, Humes does not explicitly teach that said stacks of mail pieces are received in *containers* at one or more holding facilities for gathering said containers into one or more pools.

Oh, Je H. (Oh) teaches a system for processing mail, wherein mail pieces received from senders accumulated in containers 34, said containers 34 are accumulated/pooled at a holding facility 31 for further pre-sorting and delivery to a mail service (Fig. 1, items 31 and 34; C. 5, L. 48-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Humes to include that said stacks of mail pieces are received in containers wherein said containers 34 are accumulated at a holding facility 31 for further pre-sorting and delivery to a mail service, as disclosed in Oh, because it would advantageously allow to accumulate a large number of mail pieces for subsequent conveyance, as specifically disclosed in Oh (C. 5, L. 52-53).

Information as to: "*wherein a program rate of postage is applied to each of said one or more mail pieces, said program rate being less than a full rate set by a postal service for mailing an unsorted mail piece*" indicates the intended use of the system, not a structural element. Therefore, said additional limitations is given no patentable weight. MPEP 2106 (II) (C) states: "*Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.*"

Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 528-531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from

a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987).

Thus the structural limitations of Claim 1 are disclosed in Humes and Oh as described herein. Also, as described, the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 37,

Humes teaches an apparatus for processing mail pieces, comprising:

a transport business for receiving stacks of mails from said senders and gather said stacks into one or more hoppers (Figs. 2 and 3; items 44-45; C. 3, L. 61-62);

a pre-sorting business to receive said pools from said holding facilities, sort said mail pieces into said pre-sorted batch, and tender said batch to a postal service (Fig. 3; items 61 and 63; C. 5, L. 34-38).

While Humes does teach receiving stack of mail pieces, Humes does not specifically teach that said stacks of mail pieces are received in containers, which are delivered via a transport business.

Oh teaches a system for processing mail, wherein mail pieces received from senders accumulated in containers 34, said containers 34 are accumulated/pooled at a holding facility 31 for further pre-sorting and delivery to a mail service (Fig. 1, items 31 and 34; C. 5, L. 48-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Humes to include that said stacks of mail pieces are received in containers for delivery by a carrier, as disclosed in Oh, because it would advantageously allow to accumulate a large number of mail pieces for subsequent conveyance, as specifically disclosed in Oh (C. 5, L. 52-53). Furthermore, cooperation disclosed between business entities in Humes and Oh indicates that said entities bound by an agreement.

Claim 57,

Humes teaches a method for processing mail pieces, comprising:

receiving one or more stacks of mail pieces (Fig. 1, items 1-4);  
unpacking said stacks and sorting said mail pieces into a pre-sorted batch (Fig. 3; items 61 and 63; C. 5, L. 34-38).  
tendering said pre-sorted batch to said postal service facility for mailing at an entry rate of postage (Fig. 3; items 61 and 63; C. 5, L. 34-38).:

While Humes does teaches receiving stack of mail pieces, Humes does not specifically teach that said stacks of mail pieces are received in containers.

Oh teaches a system for processing mail, wherein mail pieces received from senders are accumulated in containers 34 for further pre-sorting and delivery by a carrier to mail service (Fig. 1, item 34; C. 5, L. 48-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Humes to include that said stacks of mail pieces are received in containers for delivery by a carrier, as disclosed in Oh, because it would advantageously allow to accumulate a large number of mail pieces for subsequent conveyance, as specifically disclosed in Oh (C. 5, L. 52-53). Furthermore, cooperation disclosed between business entities in Humes and Oh indicates that said entities bound by an agreement.

#### Dependent Claims

Claims 2, 4-13, 15-18 and 39-41, same system as recited in Claims 1, 37 and 57. The additional limitations recited in Claims 2-13, 15-18 and 39-41 indicate the intended use of the system, not a structural element. Therefore, said additional limitations is given no patentable weight. MPEP 2106 (II) (C) states: "*Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.*"

Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 528-531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from

a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987).

Thus the structural limitations of Claims 2-13, 15-18 and 39-41 are disclosed in Humes and Oh as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 58. Said method further comprising the step of commingling said mail pieces (Kara; C. 3, L. 45).

Claim 59. Said method further comprising the step of preparing a document certifying to said postal service that said pre-sorted batch is qualified for mailing at an entry rate (generating a manifest, client package report or other documentation required by the post office to accompany each mailing) (Kara; C. 3, L. 50-52).

Claim 60. Said method wherein said postal service pays a rebate to said pre-sorting business, said rebate representing the difference between said entry rate and a program rate, said program rate representing the postage applied to each of said mail pieces by said sender (commingling the mailing pieces into bundles to be delivered at the lowest available postal rate indicates obtaining the rebate) (Kara; C. 3, L. 45-49).

#### ***Response to Arguments***

Applicant's arguments filed 3/20/2006 have been fully considered but they are not persuasive.

In response to applicant's argument that the prior art does not teach or suggest "pooling of containers" (claim 1), it is noted that Oh was applied for this feature. Specifically, Oh teaches a system for processing mail, wherein mail pieces received from senders accumulated in *containers* 34, said containers 34 are *accumulated/pooled*

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at a holding facility 31 for further pre-sorting and delivery to a mail service (Fig. 1, items 31 and 34; C. 5, L. 48-53).

Applicant argues that *accumulating of containers* disclosed in Oh does not teach “pooling containers” as disclosed in claim 2 (claim 37). However, Applicant does not provide any proof, analysis or explanation why said *accumulating containers* disclosed in Oh does not equate to said “pooling of containers” as recited in claim 37. Therefore, examiner stipulates that Oh explicitly teaches a system for processing mail, wherein mail pieces received from senders are accumulated in *containers* 34, said containers 34 are *accumulated/pooled* at a holding facility 31 for further pre-sorting and delivery to a mail service (Fig. 1, items 31 and 34; C. 5, L. 48-53).

In response to applicant's argument that the prior art does not teach or suggest that mail is received in containers (claim 57), it is noted that Oh was applied for this feature. Specifically, Oh teaches a system for processing mail, wherein mail pieces received from senders accumulated in *containers* 34, said containers 34 are *accumulated/pooled* at a holding facility 31 for further pre-sorting and delivery to a mail service (Fig. 1, items 31 and 34; C. 5, L. 48-53).

Applicant argues that “Independent claim1 recites a system, not an apparatus” and “Independent claim 37 recites a cooperative enterprise, not an apparatus”.

In response to this argument, Examiner reminds Applicant that there are four statutory classes of invention under which the subject matter of the invention must come within the boundaries set forth by 35 U.S.C. 101, which states: “*any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof*”. The “system”, as recited in claim1, is not a *process, manufacture, or composition of matter*; and the “cooperative enterprise”, as recited in claim 37, is not a *process, manufacture, or composition of matter*. Therefore, applicant's argument are vague and indefinite.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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5/19/2006



IGOR N. BORISOV  
PRIMARY EXAMINER